REMARKS

In the July 5, 2000 Office Action, the Examiner rejected the pending claims under 35 U.S.C. §§ 102, 103 and 112. In the ensuing sections of this Amendment, applicant will respond to those rejections and attempt to highlight the differences between the amended claims and the cited references such that it becomes apparent to the Examiner that these rejections should be reconsidered. With respect to the § 112 rejections, applicant has amended the claims as requested by the Examiner. Applicant wishes to thank the Examiner for his suggestions for resolving the §112 issues.

Applicant firmly believes that the above amendments and the following comments will convince the Examiner that the rejections of claims 1 through 20 should be reconsidered and withdrawn. In particular, the applicants would like to draw the Examiner's attention to applicant's novel use of an aqueous based colorant composition to provide a one step method for coloring and highlighting hair, which successfully colors and highlights hair fibers varying in tonality, hue and/or shade. Applicant respectfully submits this Request for Reconsideration is fully responsive to the Office Action dated July 5, 2000, and that claims 1-3 and 5-68 are in condition for allowance.

With respect to the amendment of the abstract, the specified language was changed to reflect the language of the specification. No new matter has been added.

I. THE INVENTION

The present invention relates to a method and composition for simultaneously coloring and highlighting hair. The composition contains inorganic persulfates, such as alkalai metal or alkaline earth metal persulfates. The composition contains hydrogen peroxide and cationic dye molecules, such as azo, phenazine, thiazine and mixtures thereof.

The method involves combining a powdered persulfate, an aqueous developer containing hydrogen peroxide, and an aqueous based colorant compound immediately prior to application. Through this combination of compounds, the one step coloring and highlighting method can be accomplished.

II. THE EXAMINER'S REJECTIONS

In the July 5, 2000 Office Action, the Examiner rejected Claims 5-20 under 35 U.S.C. 112, second paragraph as "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention". Applicant has the amended claims in accordance with

the suggestions of the Examiner.

The Examiner also rejected Claims 1-4 under 35 U.S.C. 102(b) as being anticipated by Hoyu. (JP 9-067,235). In the opinion of the Examiner, Hoyu,

> "exemplifies a composition for bleaching hair which contains 11% by weight inorganic persulfates (including 9% by weight sodium persulfate), about 4.8% by weight hydrogen peroxide, and 1% by weight of a quaternary ammonium containing cellulose ether, which reads on the claimed cationic surfactant compounds...Hoyu, therefore, clearly anticipates compositions as claimed."

The Examiner also rejected Claims 1-4 under 35 U.S.C. 102(a) as being anticipated by Goldwell. (DE 19721785). The Examiner believes that Goldwell exemplifies a composition which,

> "contains 0.64% by weight of azo and phenazine cationic dyes, 8.85% by weight inorganic persulfate (including potassium persulfate), 1.28% by weight hydrogen peroxide, and 2.92% by weight of the cationic surfactant/compound hydroxypropyl guar trimmonium chloride. Goldwell therefore anticipates compositions as claimed."

The Examiner also rejected Claims 1-14 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over Goldwell. In the opinion of the Examiner,

> "The office holds the position that because Goldwell's processes result in the application of the same components as claimed in the claimed amounts at the claimed pH's, Goldwell's processes are not patentably distinct from those as claimed, absent a showing otherwise."

Applicant firmly believes that the above amendments and the comments that follow will convince the Examiner that these rejections should be reconsidered and withdrawn. In short, applicant's invention is different from that disclosed in the prior art.

III. THE EXAMINER'S REJECTIONS SHOULD BE RECONSIDERED

Applicant respectfully submits that the present claims are neither rendered obvious nor anticipated by the cited references. On further reflection, applicant is confident that the Examiner will recognize that any rejections based on Hoyu and Goldwell could only be the result of hindsight reconstruction of the applicant's invention. Moreover, new claims 21-63 are not taught nor rendered obvious by the cited references.

As discussed above, the present invention is a one step method to color and highlight hair and a composition therefor.

Applicant believes the Examiner's rejection under 35 U.S.C. §112 with respect to claim 15 is no longer applicable as claim 15 has been amended in accordance with the Examiner's suggestions.

With respect to the rejection of claims 5-20 under 35 U.S.C. §112, applicant submits that the term "aqueous based colorant composition" is not "unclear as to what this composition

comprises." The Examiner asks, "For example, is a colorant required?" The term "aqueous based colorant composition" is adequately described in the specification to contain "one or more cationic dye molecules in aqueous medium." (See Specification, Page 14, lines 6-7.) The term "cationic dye molecule" is further defined as "any hair colorant compound, or dye, that has a positive charge." Clearly, the term is adequately defined within the specification.

With respect to the rejection of claims 1-4 under 35 U.S.C. §102(b), it is black letter law that to be anticipatory, a prior art reference must disclose each and every element of the claim or claims at issue. Reviewing Hoyu, applicant respectfully submits that Hoyu is directed towards a composition for bleaching hair, which does not contain each and every element of amended claim 1. Hoyu does not claim or teach a composition for coloring and highlighting hair.

The Examiner relies on Hoyu, claiming that Hoyu illustrates "a composition for bleaching hair which contains 11% by weight inorganic persulfates, about 4.8% by weight hydrogen peroxide, and 1% by weight of a quaternary ether; which reads on the claimed cationic surfactant compounds." As written, the Examiner claims that Hoyu "clearly anticipates [claim 1] as claimed."

Applicant would like to thank the examiner for bringing an

obvious typographical error to her attention. Prior to the amendment contained herewith, claim 1 of the current application purported to claim a composition containing 1-20% inorganic persulfate, 1-20% hydrogen peroxide, 0-10% of at least one cationic dye molecules and 0.01-20% of one or more cationic surfactants. As written, claim 1 was only anticipated by Hoyu if read as an attempt to claim a hair bleaching agent, by claiming protection for a composition containing 0% cationic dye molecules. Such a composition would not be a hair colorant, rather, it would only be a hair bleaching agent such as that disclosed by Hoyu. The current application claims a one step method and composition for simultaneously coloring and highlighting hair. This process necessarily involves the presence of cationic dye molecules disclosed in the specification for coloring the hair.

Amended claim 1 contained herewith includes cationic dye molecules as a necessary element in the claim. The claim as amended requires 0.01-10% of at least one or more cationic dye molecules. This range is supported by the specification (page 4, line 19) and is indisputably what applicant disclosed and intended to claim. Such a composition is clearly not anticipated by Hoyu. In fact, simply because Hoyu is a patent involving a hair bleaching agent, and not a hair dying composition, dye

molecules are necessarily absent from Hoyu. In fact, no such cationic dye molecules are disclosed in the Hoyu patent. Claim 1, as amended, necessarily includes the presence of cationic dye molecules, thereby removing it from the scope of Hoyu, and rendering it unanticipated by Hoyu. Therefore, claim 1, as amended cannot be anticipated by Hoyu, because Hoyu does not disclose each and every element of the claim 1 as amended, specifically the presence of cationic dye molecules.

With respect to the Examiner's rejection of claims 1-4 under 35 U.S.C. §102(a) with regard to Goldwell, it is black letter law that to be anticipatory, a prior art reference must disclose each and every element of the claim or claims at issue. However, Goldwell does not disclose an improvement disclosed by the current application. Goldwell discloses a combination of a xanthene-based hair dyeing agent, a peroxide based developer and a persulfate based bleaching compound. The current application discloses that a xanthene-based composition is not suitable for use by those who have sensetive or otherwise treated hair.

Goldwell discloses a composition which contains xanthan gum (see CALPUS Abstract), thereby falling outside the scope of the current invention. Goldwell is similar in scope to Japanese Patent Publication No. 08175940, (cited in the current application on page 2), wherein both disclose a product

containing a xanthene-based dyeing agent, not suitable for use by those with sensitive or chemically treated hair. Therefore, claims 1-4 cannot be anticipated by Goldwell, because Goldwell discloses a composition containing xanthan gum, a disadvantage of the prior art for which this invention was specifically designed to overcome.

Further, the Examiner cites In re Hack 245 F.2d 246 (1957) and In re Albertson 332 F.2d 379 (1964) for the proposition that "[t]he intended use of a claimed composition is given little, if any, patentable weight." The Examiner erroneously relies on these two cases for the proposition that the claimed subject matter should be given less patentable weight because of its intended use with respect to a §102 rejection. In re Hack and In re Albertson hold that merely claiming a new use for an old chemical composition does not automatically overcome a §103 obviousness rejection. The Examiner's reliance on In re Hack and In re Albertson is misplaced.

With respect to the §103 obviousness rejection of claims 1-14 and 16-20, with respect to Goldwell, the Examiner's rejection could only be the result of hindsight reconstruction of the applicant's invention. The Examiner benefits from having the teachings of applicant's specification before him -- Goldwell did not.

Specifically, the applicant respectfully points out that, standing on its own, the reference provides no justification for the combination asserted by the Examiner.

> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The cited reference provides no such suggestion or incentive for a one step method to color and highlight hair and a composition therefor as claimed by the applicant. The cited reference does not identify a pH either, as the Examiner admits, the pH is unidentified in Goldwell. Further, the cited reference, "does not appear to teach the addition of film forming polymers to the aqueous developer solution." Finally, The Examiner readily admits that "Goldwell does not exemplify a method as claimed. Particularly, the patentee does not appear to specifically teach water-containing colorant compositions as claimed." Therefore, Goldwell does not teach the aqueous composition necessary for the one step method and composition therefor which is disclosed and claimed in the current application. Therefore, the obviousness rejection could only be the result of a hindsight view with the benefit of the

applicant's specification. However,

> "[t]o draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction--an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." (citations omitted) Sesonics v. Aerosonic Corp. 38 USPQ 2d. 1551, 1554 (1996).

Under the circumstances, applicant submits that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983):

> "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." Id.

Therefore applicant submits that the only "motivation" for the Examiner's expansion of the cited reference to encompass applicant's invention is provided by the teachings of applicant's own disclosure. No such motivation is provided by the reference itself, or anywhere else in the prior art.

The Examiner claims that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a powdered persulfate-containing-, aqueous developer-, and colorant-composition as claimed...because such

compositions and methods fall within the scope of those taught by Goldwell." However, the Examiner readily admits that "Goldwell does not exemplify a method as claimed. Particularly, the patentee does not appear to specifically teach water-containing colorant compositions as claimed." Therefore, Goldwell clearly does not teach the aqueous composition necessary for the one step method and composition therefor which is disclosed and claimed in the current application.

With respect to the §103 obviousness rejection of claims 1-14 and 16-20, with respect to Goldwell, in further view of Yoshihara, the combinations advanced by the Examiner would only be proper if supported by the references themselves. However, Goldwell and Yoshihara both fail to support the combination. Quite frankly, these references are unrelated to each other. Moreover, even if the Examiner's reliance on Yoshihara and Goldwell was proper (of course, applicant believes that it is not), the Examiner still needs to rely on applicant's specification to supply additional elements that are completely absent from either reference. This is simply not proper.

The Examiner claims that Yoshihara teaches the addition of silicones to hair colorant compositions results in improved hair texture. The Examiner claims it would then have been obvious to one of ordinary skill in the art at the time of invention to add

silicone to hair colorant products in view of Goldwell and Yoshihara. The Examiner's emphasis on Goldwell is misplaced as discussed above, and the emphasis on Yoshihara is misplaced as well. Neither discloses a method for applying a single composition to hair for coloring purposes. Further, although the Examiner claims that Yoshihara teaches that silicones are added to hair care compositions to improve hair texture, the elements of the underlying claim are absent from Yoshihara, which claims a dialkylene glycol monoalkyl ether, an aromatic alcohol and a weak acid. Therefore, Yoshihara does not anticipate the current composition as claimed, in light of Goldwell.

> Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed.Cir. 1984) (emphasis in original).

The Examiner contends that it would be obvious to combine the teachings of Goldwell or Yoshihara with the teachings of the present invention to arrive at applicant's invention. This combination is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that it is actually an

"obvious to try" argument. Of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed.Cir. 1986).

Under the circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed.Cir. 1983):

> It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

Applicant submits that the only "motivation" for the Examiner's combination of references is provided by the teachings of the applicant's disclosure. No such motivation is provided by the references themselves; nor could there be in view of the difference in subject matter.

The Examiner rejected claims 5-8, 11 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Henkel (DE 2,624,690). The Examiner claims that Henkel teaches a three part blonding mixture for hair, and it would have been obvious to one ordinarily skilled in the art at the time the current invention was made to formulate a powdered persulfate composition, an

aqueous hydrogen peroxide solution and an aqueous colorant which contains a cationic dye, because such compositions fall inside the scope of the teachings of Henkel. Once again the composition pointed to by the Examiner does not teach the single composition claimed in the current application. The powdered composition claimed in part (i) of amended claim 5 is not taught in the prior art cited to by the Examiner. Nor is the powdered composition suggested by any of the prior art cited by the examiner. The phase distinction is another of the list of differences between the prior art and the current invention. Therefore, the Examiner's reliance on Henkel is misplaced.

In conclusion, applicant has disclosed a one step method for simultaneously coloring and highlighting hair, and a composition therefor which represents a significant departure from the cited references. The cited references neither teach nor suggest the novel and nonobvious features of this invention.

CONCLUSION

In view of the foregoing, the applicant respectfully submits that the present invention represents a patentable contribution to the art and the application is in condition for allowance. Early and favorable action is accordingly solicited.

Respectfully submitted,

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